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An Shun Huang

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ART UNIT

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1761

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/738,656  
Filing Date: December 15, 2000  
Appellant(s): HUANG ET AL.

**MAILED**

MAY 26 2006

**GROUP 1700**

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Thaddius J. Carvis  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/8/06 appealing from the Office action  
mailed 12/19/02.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct; however, there is minor change as indicated below.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The 112 first paragraph rejection of claims 1,8,15,19,21 and 22 is hereby withdraw.

**(7) Claims Appendix**

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The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,707,365

HAYNES et al

11-1987

Original Chocolate Chip Cookies Recipes, 1997-1998.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynes et al in view of the paper on "Original Chocolate Chip Cookies Recipes".

Haynes et al disclose a flavor system having high chocolate flavor impact. The system has a high level of cocoa solids, a high level of a mixture of pyrazines and high ratios of certain dimethyl pyrazines to trimethyl and tetramethyl pyrazines. This

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chocolate flavor system is useful in formulating chocolate chips to use in chewy cookies. The chocolate chips comprise a confectionary fat, a sugar or sugar alcohol, emulsifiers, optional ingredients and the chocolate flavor system. A formulation for the chocolate chips is disclosed in column 12. The chips contain ethyl vanillin in an amount of .1% and the chips are used in a cookie formulation .

Haynes et al do not disclose a combination of small and larger chips in the cookies, the count per pound of the chip, the PH and the amount of the chips.

The Cookies Recipes disclose numerous variations to the recipes for chocolate chips cookies to obtain different flavor options. For example, there is a teaching of substituting milk chocolate M&M Baking Bits and Milk Chocolate Chips, Semi-sweet Chocolate Chips and Milk Chocolate Chip, White Chips and Peanut Butter Chip and many other substitutions.

As the recipes show, there are many variations to making chocolate chip cookies and the flavor options are numerous. The addition of M& M Baking Bits and Milk Chocolate Chips would give different sizes and different flavor. It would have been obvious to one skilled in the art to use the Haynes et al chocolate chips in combination with other types of chips or chocolate products depending on the texture, flavor and taste desired. The limitation of extending flavor otherwise diminished by storage will obviously take place in the cookies of the prior art when different types of flavoring chips are used. For instance, the chips disclosed by Haynes et al are enhanced flavored chip; if such chips are used with regular chocolate chips, then some chips will have enhanced flavor composition over the other chips and the cookie base. As the recipes show, there

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are many substitutions that can be done to obtain different flavor options; the particular flavor selected would have been a matter of preference. It would also have been obvious to produce the chips in any size desired. The size of the chips, the amount of chips used, the use of small or large or combination of both, the use of larger amount of one size of chips over another size, or different flavor chips all depend on the taste perception and flavor desired and these variations would have been within the skill of one in the art as the recipes show there are many variations in the making of chip-containing cookies and the selection of any particular option would have been a matter of personal preference. The taste perception and flavor vary among individuals; therefore, it would have been obvious to vary the above parameters according to the taste and flavor desired. Since the chips disclosed in Haynes are chocolate chips, it is obvious the Ph would be within the range as claimed.

Claims 1,8,15,19,21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In all relevant claims, the terms "freshness perception" and "fresh flavor" are indefinite because they are relative terms; what would be considered as "freshness perception" and "fresh flavor"? These qualities are subjective evaluation and vary among individuals. The specification does not define the terms.

#### **(10) Response to Argument**

On page 13 of the appeal brief, appellant argues the terms used in the claims are not indefinite. Appellant makes reference to paragraph 0032 of the application

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publication. However, the paragraph does not define what "freshness perception" and "fresh flavor" mean. The language "freshness" is used; but, there is no definition given. What is perceived as fresh by one might not be the same as other. Appellant argues that test data is provided based on scoring of samples based on actual smell and taste. However, the specification does not give any quantitative analysis of samples that would define freshness perception and fresh flavor. Freshness is an subjective evaluation and one skilled in the art would not readily understand what would be considered to be freshness perception and fresh flavor.

On page 15 of the appeal brief, appellant argues no reference specifically teaches the proposed combination claimed and the invention is productive of an unexpected result. This argument is not persuasive. The combining of different flavor chips in a cookie product is taught in the cookies recipes. On page 9 of the article, there is teaching of replacing chocolate chips with M&M Mini Milk Chocolate Baking Bits, White Chips and Semi-Sweet Chocolate Chip. Page 6 teaches substituting Milk Chocolate Chips for Semi-Sweet Chip. Pages 4-5 also teach various other substitutions. Thus, there are ample teachings of combining different flavor chips having different sizes in a cookie product. Haynes et al disclose enhanced flavor chocolate chips which are used in cookies; it would have been obvious to use the Haynes et al chips in combination with other known chips disclosed on pages 6-7 of the recipe article when desiring to obtain cookies with different flavor and taste. The Haynes et al chips are enhanced flavor chips; thus, the flavor profile will be different from regular milk chocolate chips. Thus, when a combination of such chips is used; the

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flavor of one chip will be enhanced over the other chips. The combination would have been obvious to one skilled in the art because the recipes teach different combinations of chips having different flavor and size are used in cookie product. For example, when peanut butter chips are used in combination with butterscotch chips; the flavor of one type of chip is different from the other. Appellant argues the claimed invention has unexpected result; however, appellant has not presented any comparative showing between the claimed product and the prior art product to show unexpected result.

On page 15, appellant further argues the amounts of concentration are described as different and that the added flavor be in a concentration greater than present in the basecake and other of the chips. The difference pointed out by appellant is inherent in the prior art because the Haynes et al chips are enhanced flavor chips which mean the flavor composition is greater than regular chocolate chips which are not made using the chocolate flavor system disclosed by Haynes et al. This precise difference is discussed in column 2 lines 32-50 of the Haynes et al reference. The chips are added to cookie base; thus, the base which is made of dough does not have the chips; thus, of course, flavor in the chip is greater than the base cookies. Appellant points to the different limitations in the dependent claims and generally concludes that there is no motivation for using different flavor concentration in specific of differently sized chips for any purpose, much less for appellant's objective. The examiner respectfully disagrees with appellant because the rejection sets forth why one skilled in the art would want to combine different flavor chips. The combination is for the obvious reason of obtaining different flavor, taste, texture etc.. Appellant does not argue or present any evidence to



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dispute why the combination would not have been obvious to one skilled in the art. On page 16, appellant points to Figure 2 that appellant states shows stabilization for 26 weeks. This length of time is not claimed; thus, it is not a limitation for consideration.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Lien Tran

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Conferees:

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